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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/759,784 | 01/12/2001 | Cary Lee Bates | ROC920000007US2 | 9669 |

46296 7590 12/20/2004

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EXAMINER

D AGOSTA, STEPHEN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2683

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,784

Applicant(s)

BATES ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,16-22 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-9 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 8-9, 16-22 and 26 have been considered but are moot in view of the new ground(s) of rejection. New art has been provided as per the Office Action below.

Election/Restrictions

Per conversation with applicant's attorney (Derek Martin, 417-358-4700), claims 22 and 26 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

This was a three-way restriction as follows:

Group 1: Claims 8-9 & 16-21 – Deals with Call routing found in 455/445.

Group 2: Claim 22 – Deals with Call Alerting found in 455/567

Group 3: Claim 26 – Deals with Location at Remote Station 455/456.6 and/or Location display 455/457.

The applicant's attorney returned the examiner's call on 12-14-04 and elected Group 1 for prosecution. The other claims have been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Syed et al. US 6,038,451 and further in view of Dennison et al. US 5,235,633 and Cosgriff et al US 6,704,796.

As per **claims 8 and 16**, Syed teaches a telephone system (title, abstract and figure 1) comprising:

- a portable phone (figure 1, #11);
- a second phone (figure 2, #13 is a wired phone) and
- a call router that automatically rings the second phone without requiring input from a user of the portable phone when a call is received for the portable phone if the portable phone is within a predetermined physical-relationship with the second phone as indicated by the position detector in the portable phone (figure 1, #27 is the "call routing function" that has knowledge of the mobile and routes calls to the wireline if/when the location-finding system #25 identifies that the mobile is near the wireline, see C2, L35-48).

But is silent on portable phone that includes a position detector that detects the position of the portable phone AND wherein the call router further rings the portable phone when a call is received for the second phone if the portable phone is within the predetermined physical relationship with the second phone.

Dennison teaches the phone having a GPS receiver on it to determine it's own position (abstract) instead of Syed's design whereby the network determines the

phone's position. One skilled would use either design such that the position of the phone can be determined. GPS is typically more accurate.

The examiner notes that Syed teaches forwarding a call originally intended for a wireless unit to a wireline unit but does NOT teach the opposite (eg. forwarding a wireline call to a mobile). Cosgriff teaches providing the SAME features to a user who has both wireless and wireline phones (abstract and C9, L22 to C10, L22). The excerpt below shows Cosgriff's teaching for both forwarding operations:

Wireline program 300 determines the line type associated with wireless handset 102.sub.1 (step 1050). Based on the determined line type, wireline program 300 retrieves from Aspect Table 216a the address of the corresponding procedure in memory 210 for forwarding the call to wireless handset 102.sub.1 (step 1060). Finally, wireline program 300 executes the identified procedure to forward the call (step 1070).

Wireless program 400 then determines the line type associated with wireline telephone 101.sub.1 (step 1050). Based on the determined line type, wireless program 400 retrieves from Aspect Table 216a the address of the corresponding procedure in memory 210 for forwarding the call to wireline telephone 101.sub.1 (step 1060). Finally, wireless program 400 executes the identified procedure to forward the call (step 1070).

Since Cosgriff teaches call forwarding from mobile-to-wireline and wireline-to-mobile, it is the examiner's interpretation that Cosgriff provides the motivation for one skilled to "reverse" Syed's call routing such that a call to a wireline phone would be routed to the user's wireless phone (when nearby) as taught by Syed. This is because Cosgriff provides the same functions to both phones. To do this, one skilled would use the same hardware/software disclosed by Syed (and Dennison) along with a (new) software module that determines if a call is intended for a wireline phone, determines if that user is nearby with their mobile phone, and subsequently rings the mobile phone (eg. since the program will determine that the user is not at their wireline phone but is still in the area, maybe down the hall at a meeting).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed, such that the mobile phone includes a position

detector AND wherein the call router further rings the portable phone when a call is received for the second phone if the portable phone is within the predetermined physical relationship with the second phone, to provide means for determining the position of the phone (via GPS phone receiver) and forwarding wireline calls to the mobile if/when nearby their wireline phone.

Claims 9 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Syed/Dennison/Cosgriff and further in view of Murkejee US 6,405,041.

As per **claims 9 and 17**, the combination teaches claim 8/16 **but is silent on** wherein the call router rings the portable phone at the same time the call router rings the second phone, and connects the call to whichever of the portable and second phones that is answered first.

Mukerjee teaches simultaneously ringing a subscriber's wired and wireless phones simultaneously (abstract) and that ringing occurs until either the wired or wireless unit answers the call (C5, L20-22).

It would have been obvious to one skilled in the art at the time of the invention to modify Syed/Dennison/Cosgriff, such that both phones are rung until one is answered, to provide means for the user to select which phone they want to use to answer the call.

Claims 18-21 rejected under 35 U.S.C. 103(a) as being unpatentable over Syed/Dennison and further in view of Hardouin EP0876071.

As per **claim 18**, Syed teaches a telephone system (title, abstract, figure 1) comprising:

- (A) a portable phone (figure 1, #11);
- (B) at least one geographical region (Syeds teaches routing a call based upon the geographical location/region of the user's mobile in relation to a wireline phone),
- (C) a mechanism that receives the position of the portable phone from the position detector, and that determines from the position of the portable phone whether the portable phone enters or exits a defined geographical region (Syed's figure 1, #27 is the "call routing function" that has knowledge of the mobile and routes calls to the wireline

if/when the location-finding system #25 identifies that the mobile is within a "region" near the wireline, see C2, L35-48); and

(D) a call router that routes a telephone call according to the phone parameters for a region (C2, L35-48 teaches routing a call to a wireline phone when the "if the portable phone is within a predetermined physical-relationship with the second phone").

But is silent on portable phone that includes a position detector that detects the position of the portable phone AND each defined geographical region having corresponding phone parameters that determine how a call is rung and routed AND a call router that rings a phone according to parameters of the region.

Dennison teaches the phone having a GPS receiver on it to determine it's own position (abstract) instead of Syed's design whereby the network determines the phone's position. One skilled would use either design such that the position of the phone can be determined.

Hardouin teaches determination of a wireless handset's location and audio/vibration alerting based on location (abstract, "users may choose to specify areas designated by the system administrator for audio alerting or vibration alerting" and "the system administrator may determine different alerting information for different areas of the building).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed, such that portable phone that includes a position detector AND each defined geographical region having corresponding phone parameters that determine how a call is rung and routed AND a call router that rings a phone according to parameters of the region, to provide means for determining the position of the phone (via GPS phone receiver) and ringing the phone(s) in a specific manner based upon geographical location (eg. to alert the user that they are near a mobile/wireline phone that the call can be routed to).

As per **claim 19**, the combination teaches claim 18 **but is silent on** wherein the position detector comprises a global positioning system (GPS) sensor.

Dennison teaches the phone having a GPS receiver on it to determine it's own position (abstract) instead of Syed's design whereby the network determines the phone's position. One skilled would use either design such that the position of the phone can be determined.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed/Dennison/Hardouin, such that a GPS sensor is used, to provide a more accurate location determination than the network's location determining system taught by Syed.

As per **claim 20**, the combination teaches claim 18 wherein the call router in (D) resides in a telephone company network that is coupled to the portable phone (figure 1 #27 is the MSC/HLR/VLR switching system/router that routes the calls based on the location finding system #25 and has knowledge if/when the user's mobile is in a geographical region near a specific wireline phone, abstract);

But is silent on at least one geographical region in (B) and the mechanism in (C) reside within the portable phone.

For (B): Hardouin teaches determination of a wireless handset's location and audio/vibration alerting based on location (abstract, "users may choose to specify areas designated by the system administrator for audio alerting or vibration alerting" and "the system administrator may determine different alerting information for different areas of the building). The ability for the phone and/or system to store the region data is inherent since both the phone and system comprise processors with memory.

For(C): Dennison teaches the mobile phone having a GPS receiver on it (abstract) which inherently requires the phone to know it's geographical location/region.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed/Dennison/Hardouin, such that at least one geographical region in (B) and the mechanism in (C) reside within the portable phone, to provide means for offloading processing requirements from the system onto the

mobile phone as well as for storage of data on the phone if/when the network is unavailable to receive any/all phone configuration parameters from the user.

As per **claim 21**, the combination teaches claim 18 and the call router in (D) reside in a telephone company network that is coupled to the portable phone (figure 1 #27 is the MSC/HLR/VLR switching system/router that routes the calls based on the location finding system #25 and has knowledge if/when the user's mobile is in a geographical region near a specific wireline phone, abstract);

but is silent on wherein the portable phone communicates its detected position to the call router, and wherein the at least one geographical region in (B), and mechanism in (C), reside in the portable phone.

For (B) and (C): Dennison teaches a phone with GPS receiver (abstract) that would communicate it's position to the network/call router since GPS is more accurate than most/all network location-determining systems.

Hardouin teaches a system level table (figures 4 and 5) that resides in phone network (eg. BSC/éTS).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Syed/Dennison/Hardouin, such that the portable phone communicates its detected position to the call router, and wherein the at least one geographical region in (B), and mechanism in (C), reside in the portable phone, to provide means to offload processing requirements from the system onto the mobile phone (so that the phone initiates the process whereby it determines when it is in a region that may require the call router to route wireless calls to a wireline phone instead of the network having to do the processing for this operation for all phones in it's region).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta

A handwritten signature in black ink, appearing to be 'SD' or 'D'Agosta' in a stylized, cursive script.